

PATENT
Customer No. 22,852
Attorney Docket No. 9314.0046-00
Express Mail Label No. EM 100825270 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Michael DIXON et al.)	Group Art Unit: 2834
)	
Application No.: 10/589,684)	Examiner: To Be Assigned
)	
Filed: January 31, 2005)	
)	Confirmation No.: 9914
For: POSITIONER DEVICE)	

MAIL STOP PCT
ATTENTION: Office of PCT Legal Administration
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

DEC 30 2008

**PCT LEGAL
ADMINISTRATION**

Sir:

RENEWED PETITION UNDER 37 C.F.R. §1.47(a)

In response to the Decision on Petition under 37 C.F.R. § 1.47(a) mailed October 30, 2008, and pursuant to 37 C.F.R. § 1.47(a), Applicant Michael J. Dixon renews his petition for acceptance of the above-identified application on behalf of himself and a non-signing joint inventor, Terence J. Herbert.

An internet search was conducted to determine if any additional addresses could be found for the non-signing inventor Terence J. Herbert. Using <http://www.192.com>, a website for finding people and addresses in the United Kingdom, searches for Terence J. Herbert indicated that a Terence J. Herbert was on the electoral rolls at an address on Pelham Way, Cottenham, in Cambridge from 2002-2007, and that a Terence J. Herbert was on the 2008 electoral roll at an address on Clipped Hedge in Hertfordshire. The searches also indicated that the two addresses have at least one occupant in common. Printouts from these searches are attached. Because the searches found a Terence J. Herbert and similar occupants at addresses similar to those that are the

last-known addresses of Terence J. Herbert, Applicant believes that the non-signing inventor is still located at one of the last-known addresses. Accordingly, Applicant again sent a copy of the application and Declaration to these addresses for the signature of Terence J. Herbert.

To satisfy the requirement of providing factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, Applicant submits copies of Fedex tracking receipts for two different last known addresses in which delivery of the Declaration was attempted.

The first delivery receipt (tracking number 792783476398) indicates that delivery was successfully made at one of Mr. Herbert's last known addresses at 15 Clipped Hedge, Hatfield Heath, Hertfordshire CB62EW, Great Britain, and signed for by B. Rown on November 7, 2008. However, the enclosed Declaration was, to the knowledge of the undersigned, not signed, nor returned to Applicant for filing in this application.

The second delivery receipt (tracking number 792783479077) indicates that delivery was attempted at Mr. Herbert's other last known address at 75 Pelham Way, Cottenham, Cambridgeshire CB48YQ, Great Britain, on November 7, 2008, and was returned by Fedex as having an incorrect address and therefore, delivery was not completed. A copy of the Fedex envelope labeled with the wrong address indicator dated November 7, 2008, is enclosed. Also enclosed is a copy of the Fedex envelope returning the contents from the incomplete delivery shipment back to Gary J. Edwards, with a ship date of November 17, 2008.

Because the delivered Declaration was not signed, nor returned by the inventor Terence J. Herbert, it is clear that Terence J. Herbert is refusing to sign the Declaration and join in this application.

This renewed Petition is being filed concurrently with the Declaration and Power of Attorney document for inventor Michael J. Dixon. In the Declaration, the signature of joint

inventor, Terence J. Herbert, is missing because joint inventor Mr. Herbert refuses to execute the Declaration and join in the above-captioned application. In support of this renewed Petition, Applicant re-submits the declaration of Keith Dhese, employed by Thorlabs Ltd., and Gary J. Edwards, Ph.D., Partner, at Finnegan, Henderson, Farabow, Garrett, & Dunner, LLP, that fully describe the facts relied upon to establish that joint inventor Terence J. Herbert refuses to execute the Declaration and join in the above-captioned application. The declaration of Gary J. Edwards also states the last known address of Terence J. Herbert, in accordance with 37 C.F.R. § 1.47(a).

Applicant respectfully submits that the fee payment of \$200.00 associated with the filing of the Petition under 37 C.F.R. § 1.47(a) was previously paid on October 3, 2008. Accordingly, no petition fee is due at this time.

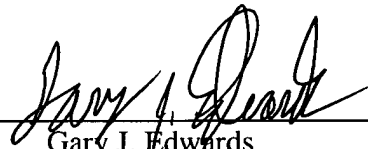
Please grant any extensions of time required to enter this Petition and charge any other fees due in connection with the filing of this Petition to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 30, 2008

By: _____



Gary J. Edwards
Reg. No. 41,008
(650) 849-6622

EM100825270US

12/18/2008

192.com - Results List



Sponsored Links

Emi-Mec Herbert 2D

Two EMI-MEC Herbert 2Ds for sale All enquiries welcome
www.belpel.eclipse.co.uk

Electoral Roll 2002 - 2007 [Sign in or register and get credits](#) to view full details

TERENCE HERBERT XX PELHAM WAY COTTENHAM CAMBRIDGE XXXXXXXX [Full Details](#)
other occupants NINA HERBERT, EMILY-JAYNE CHAPMAN, CLIFFORD J CHAPMAN, KAREN M CHAPMAN

Family Records (post-1984)

26 results

Births (1 matching record)

TERENCE HERBERT Mother's Maiden Name Registration District Year of Registration Month of [view results >>](#)
Registration

Marriages (1 - 17 matching records)

TERENCE HERBERT Spouses Surname Registration District Year of Registration Month of [view results >>](#)
Registration

Deaths (1 - 8 matching records)

TERENCE HERBERT Date of Birth Registration District Year of Registration Month of [view results >>](#)
Registration

Search [pre-1984](#) family records for **TERENCE HERBERT**

We also searched

Free Directory Enquiries	No results found
Electoral Roll 2008	No results found
Director Report	No results found
Business Directory	No results found

Need help refining your search? Call 118 119 for Directory Enquiries



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Wong, Annie

From: TrackingUpdates@fedex.com
Sent: Friday, November 07, 2008 4:37 AM
To: Wong, Annie
Subject: FedEx Shipment 792783476398 Delivered

This tracking update has been requested by:

Company Name: Finnegan, Henderson et al.
Name: Gary J. Edwards
E-mail: annie.wong@finnegan.com

Our records indicate that the following shipment has been delivered:

Reference: 09314.0046-00000
Ship (P/U) date: Nov 5, 2008
Delivery date: Nov 7, 2008 10:48 AM
Sign for by: B.ROWN
Delivered to: Receptionist/Front Desk
Service type: FedEx International Priority
Packaging type: FedEx Envelope
Number of pieces: 1
Weight: 1.00 lb.
Special handling/Services: Deliver Weekday

Tracking number: 792783476398

Shipper Information	Recipient Information
Gary J. Edwards	Terence J. Herbert
Finnegan, Henderson et al.	15 Clipped Hedge; Hatfield
3300 Hillview Avenue	Heath
Palo Alto	Hertfordshire
CA	GB
US	CB62EW
94304	

Please do not respond to this message. This email was sent from an unattended mailbox. This report was generated at approximately 6:37 AM CST on 11/07/2008.

To learn more about FedEx Express, please visit our website at fedex.com.

All weights are estimated.

To track the latest status of your shipment, click on the tracking number above, or visit us at fedex.com.

This tracking update has been sent to you by FedEx on the behalf of the Requestor noted above. FedEx does not validate the authenticity of the requestor and does not validate, guarantee or warrant the authenticity of the request, the requestor's message, or the accuracy of this tracking update. For tracking results and fedex.com's terms of use, go to fedex.com.

Thank you for your business.

11/7/2008

Wong, Annie

From: TrackingUpdates@fedex.com
Sent: Friday, November 07, 2008 5:04 AM
To: Wong, Annie
Subject: FedEx Delivery Exception

This tracking update has been requested by:

Company Name: Finnegan, Henderson et al.
Name: Gary J. Edwards
E-mail: annie.wong@finnegan.com

FedEx attempted, but was unable to complete delivery of the following shipment:

Reference: 09314.0046-00000
Ship (P/U) date: Nov 5, 2008
Estimated delivery: Nov 7, 2008
Service type: FedEx International Priority
Packaging type: FedEx Envelope
Number of pieces: 1
Weight: 1.00 lb.
Special handling/Services: Residential Delivery
Deliver Weekday

Tracking number: 792783479077

Reason Delivery Not Completed	Recommended Action
1. Incorrect Address	<u>Contact us</u> to provide correct delivery address and/or additional delivery information.

Please do not respond to this message. This email was sent from an unattended mailbox. This report was generated at approximately 7:04 AM CST on 11/07/2008.

To learn more about FedEx Express, please visit our website at fedex.com.

All weights are estimated.

Estimated Delivery displayed above is not valid for Money-Back Guarantee or delay claim purposes. Shipments delayed because of Customs or other regulatory delays are not subject to refund or credit under FedEx Money-Back Guarantee Policy. Please see FedEx Service Guide for terms and conditions of service, including FedEx Money-Back Guarantee. For more information, please contact your FedEx Customer Support representative.

To track the latest status of your shipment, click on the tracking number above, or visit us at fedex.com.

This tracking update has been sent to you by FedEx on the behalf of the Requestor noted above. FedEx does not validate the authenticity of the requestor and does not validate, guarantee or warrant the authenticity of the request, the requestor's message, or the accuracy of this tracking update. For tracking results and fedex.com's terms of use, go to fedex.com.

Thank you for your business.

11/7/2008

Wong, Annie

From: TrackingUpdates@fedex.com
Sent: Monday, November 17, 2008 9:14 AM
To: Wong, Annie
Subject: FedEx Delivery Exception

This tracking update has been requested by:

Company Name: Finnegan, Henderson et al.
Name: Gary J. Edwards
E-mail: annie.wong@finnegan.com

FedEx attempted, but was unable to complete delivery of the following shipment:

Reference: 09314.0046-00000
Ship (P/U) date: Nov 5, 2008
Estimated delivery: Nov 7, 2008
Service type: FedEx International Priority
Packaging type: FedEx Envelope
Number of pieces: 1
Weight: 1.00 lb.
Special handling/Services: Residential Delivery
Deliver Weekday

Tracking number: 792783479077

Reason Delivery Not Completed	Recommended Action
1. Unable to deliver shipment, returned to shipper	No action is required. The package is being returned to the shipper.

Please do not respond to this message. This email was sent from an unattended mailbox. This report was generated at approximately 11:14 AM CST on 11/17/2008.

To learn more about FedEx Express, please visit our website at fedex.com.

All weights are estimated.

Estimated Delivery displayed above is not valid for Money-Back Guarantee or delay claim purposes. Shipments delayed because of Customs or other regulatory delays are not subject to refund or credit under FedEx Money-Back Guarantee Policy. Please see FedEx Service Guide for terms and conditions of service, including FedEx Money-Back Guarantee. For more information, please contact your FedEx Customer Support representative.

To track the latest status of your shipment, click on the tracking number above, or visit us at fedex.com.

This tracking update has been sent to you by FedEx on the behalf of the Requestor noted above. FedEx does not validate the authenticity of the requestor and does not validate, guarantee or warrant the authenticity of the request, the requestor's message, or the accuracy of this tracking update. For tracking results and fedex.com's terms of use, go to fedex.com.

Thank you for your business.

11/17/2008

FedEx WRG ADDR Pcs: 1 1 of 1
07NOV08 12:27 Emp#: 226039 Rt#: 547
Recpt Addr: 75 PELHAM WAY RECIPIENT HAS MOVED
Pkg Trk#: 792783479077

WRONG
ADDRESS
RTS

From: Origin ID: PAOA (650) 849-6622
Gary J. Edwards
Finnegan, Henderson et al.
3300 Hillview Avenue

Palo Alto, CA 94304
UNITED STATES

SHIP TO: 1-650-849-6622 BILL SENDER
Terence J. Herbert

75 Pelham Way
Cottenham

Cambridgeshire, CB48YQ
GB

Ship Date: 05NOV08

ActWgt: 1 LB

CAD: 142221/INET8091

Account#: S *****

REF: 09314.0046-00000

DESC-1: Correspondence/No Customs Value

DESC-2:

DESC-3:

DESC-4:

EEL NO EEI 30.37(a)

COUNTRY MFG: US

CARRIAGE VALUE: 00 USD

CUSTOMS VALUE: USD

T/C: S 217662338

SIGN: Gary J. Edwards

EIN/VAT:

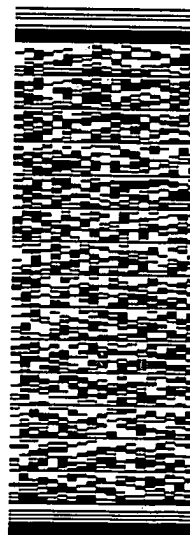
PKG TYPE: ENV

D/T: S 217662338

Total Wgt: 1 LB

TRK# 7927 8347 9077 INTL PRIORITY PM
0430

XH HTFA CB48YQ
-GB
STN



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DECLARATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that: my residence, post office address and citizenship are as stated below next to my name; I believe I am the original, first, and sole inventor (if only one name is listed below) or an original, first, and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

"POSITIONER DEVICE"

the specification of which

☐ is attached and/or

☒ was filed on August 16, 2006, as United States Application Serial No. 10/589,684 or

☐ PCT International Application No.

and was amended on

(if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate or § 365(a) of any PCT international application(s) designating at least one country other than the United States, listed below and have also identified below, any foreign application(s) for patent or inventor's certificate, or any PCT International application(s) having a filing date before that of the application(s) of which priority is claimed:

Country	Application Number	Date of Filing	Priority Claimed Under 35 U.S.C. 119	
PCT	PCT/GB2005/000320	January 31, 2005	<input checked="" type="checkbox"/> YES	<input type="checkbox"/> NO
Great Britain	0403821.2	February 20, 2004	<input checked="" type="checkbox"/> YES	<input type="checkbox"/> NO

I hereby claim the benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below:

Application Number	Date of Filing

I hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s) or § 365(c) of any PCT International application(s) designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application(s) in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56 which became available between the filing date of the prior application(s) and the national or PCT International filing date of this application:

Application Number	Date of Filing	Status (Patented, Pending, Abandoned)

I hereby appoint the following attorney and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. **FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P., CUSTOMER NUMBER 22,852.**

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Full Name of First Inventor Michael John DIXON	Inventor's Signature <i>Mike Dixon</i>	Date 14-12-06
Residence Ely, UNITED KINGDOM		Citizenship GB
Post Office Address Ash Tree Farm, "A" Furlong Drove, Little Downham, Ely, Cambridgeshire, CB6 2EW, UNITED KINGDOM		
Full Name of Second Inventor Terence James HERBERT	Inventor's Signature	Date
Residence Hatfield Heath, UNITED KINGDOM		Citizenship GB
Post Office Address 15 Clipped Hedge, Hatfield Heath, Herts, CM22 7EG, UNITED KINGDOM		

COPY

PATENT
Customer No. 22,852
Attorney Docket No. 9314.0046-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Michael John DIXON et al.)	Group Art Unit: 2834
)	
U.S. Application No.: 10/589,684)	Examiner: Not Yet Assigned
)	
International Appl. No. PCT/GB2005/000320)	
)	Confirmation No.: 9914
International Filing Date: January 31, 2005)	
)	
For: POSITIONER DEVICE)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

DECLARATION OF GARY J. EDWARDS, PH.D.

I, Gary J. Edwards, Ph.D., do hereby make the following declaration:

1. I am a partner at the law firm of Finnegan, Henderson, Farabow, Garrett, & Dunner, LLP.
2. On August 16, 2006, I filed the subject patent application in the USPTO pursuant to 35 U.S.C. § 371 on behalf of Melles Griot Limited, subsequently assigned to Thorlabs, Inc. The application names Michael John Dixon and Terence James Herbert as inventors.
3. On July 1, 2008, the undersigned sent a letter dated June 30, 2008, by the United States Postal Service International Registered Mail Service and Return Receipt Requested for International Mail to Terence James Herbert at his last known home address, 75 Pelham Way, Cottenham, Cambridgeshire CB4 8YQ, United Kingdom. In the letter, the undersigned instructed Mr. Herbert to "return the signed documents to us as early as possible, but preferably by July 20, 2008." Enclosed with this letter were:

- 1) A Declaration and Power of Attorney for his signature;
- 2) An Assignment of Patent Application for his signature; and
- 3) A copy of the specification, claims, and abstract.

A copy of the letter with the enclosures is attached at Tab 1 (39 pages).

4. On July 1, 2008, the undersigned sent an identical letter dated June 30, 2008, by the United States Postal Service International Registered Mail Service and Return Receipt Requested for International Mail to Terence James Herbert at another last known address on record to 15 Clipped Hedge, Hatfield Heath, Hertfordshire CB6 2EW, United Kingdom. In the letter, the undersigned similarly instructed Mr. Herbert to "return the signed documents to us as early as possible, but preferably by July 20, 2008." Enclosed with this letter were:

- 1) A Declaration and Power of Attorney for his signature;
- 2) An Assignment of Patent Application for his signature; and
- 3) A copy of the specification, claims, and abstract.

The letter sent to the above address was not returned by the Royal Mail Service, and delivery was also not acknowledged. A copy of the letter with the enclosures is attached at Tab 2 (39 pages).

5. On July 8, 2008, the Royal Mail Service returned the package to the undersigned in Palo Alto, CA, as they "were unable to deliver this item because addressee has gone away", A copy of the mailing envelope is attached at Tab 3 (1 page).

6. On July 30, 2008, the undersigned re-sent the previous letter (referenced in item #3) now re-dated July 30, 2008, by the United States Postal Service International Registered Mail Service and Return Receipt Requested for International Mail to Terence James Herbert at his last known home address, 75 Pelham Way, Cottenham, Cambridgeshire CB4 8YQ, United Kingdom. In the letter, the undersigned instructed Mr. Herbert once again to "return the signed documents to us as early as possible." Enclosed with this letter were:

- 1) A Declaration and Power of Attorney for his signature;
- 2) An Assignment of Patent Application for his signature;
- 3) A copy of the specification, claims, and abstract; and

A copy of the letter with the enclosures is attached at Tab 4 (39 pages).

7. On August 8, 2008, the Royal Mail Service returned the package to the undersigned in Palo Alto, CA, as "addressee unknown". A copy of the mailing envelope is attached at Tab 5 (1 page).

8. Copies of the United States Postal Service receipts dated July 1, 2008, and July 30, 2008, for International Registered Mail Service and Return Receipt Requested for International Mail service, attached at Tab 6 (2 pages).

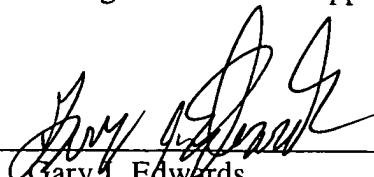
9. A copy of Mr. Herbert's employment agreement with Melles Griot is attached at Tab 7 (4 pages).

10. Based on the fact that Mr. Herbert has not responded to any of those letters, it is my opinion that Mr. Herbert is refusing to sign, or can not be found.

I further declare that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true, and understand that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and may jeopardize the enforceability of any patent issuing from the '684 application.

Dated: October 3, 2008

By: _____


Gary S. Edwards
Reg. No. 41,008
650.849.6622

EXPRESS MAIL LABEL NO. EM 100825235 US

COPY

PATENT
Customer No. 22,852
Attorney Docket No. 9314.0046-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Michael John DIXON et al.)	Group Art Unit: 2834
)	
Application No.: 10/589,684)	Examiner: Not Yet Assigned
)	
Filed: January 31, 2005)	
)	Confirmation No.: 9914
For: POSITIONER DEVICE)	

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

DECLARATION OF KEITH DHESE

I, Keith Dhesse, do hereby make the following declaration:

1. I am employed by Thorlabs Ltd., the U.K. operations manufacturing facility of Thorlabs, Inc.
2. On April 2, 2008, I was asked to assist in obtaining the signature of Terence James Herbert on the Declaration and Power of Attorney document in order to respond to a Notice of Missing Requirements issued on March 20, 2008, by the United States Patent and Trademark Office, as well as for an Assignment document, in connection with the subject patent application. The application names Michael John Dixon and Terence James Herbert as inventors.
3. In late April 2008, I asked Mr. Gordon Chapman, a friend of Mr. Herbert, to contact Mr. Herbert and ask him about signing the above-mentioned documents. Mr. Chapman

indicated that Mr. Herbert probably would not sign, but he would ask anyway. At the time, Mr. Chapman was employed by Thorlabs, Ltd., but has since terminated his employment.

4. On May 9, 2008, I e-mailed Mr. Herbert directly at THerbert@kerr-noble.com. This e-mail address was provided to me by Mr. Gordon Chapman. To this date, I have not received a response to my e-mail.

5. On May 16, 2008, I managed to get a hold of Mr. Herbert on his mobile phone. This telephone call was initiated by Allison Killock, a friend of Mr. Herbert. During this call, Mr. Herbert indicated that he would sign the papers. Ms. Killock is currently employed by Thorlabs, Ltd.

6. Subsequent attempts in late May and early June by me and Ms. Killock to follow up with Mr. Herbert to coordinate the signing of the papers were unsuccessful.

7. Based on the fact that Mr. Herbert has not responded to my initial e-mail of May 9, 2008, and subsequent attempts to reach him by me and Ms. Killock proved unsuccessful, it is my opinion that Mr. Herbert may be adverse to signing the above-mentioned documents for reasons not known to me.

I further declare that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true, and understand that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and may jeopardize the enforceability of any patent issuing from the '684 application.

Dated: 18th SEPT 2008

By: Keith Dhese
Keith Dhese
Thorlabs, GmbH